

REMARKS

A. Status of the Claims

Claim 1 was pending at the issuance of the present Office Action. Claim 3 is withdrawn as being drawn to non-elected subject matter. Claim 1 is rejected.

B. Claim Rejections – 35 USC §103

Claim 1 is rejected under 35 USC §103 as allegedly being unpatentable over Xiao in view of Clark *et al.*

MPEP §2143.03 requires that all claim limitations be considered in an obviousness determination, and the Board of Patent Appeal and Interferences (BPAI) recently confirmed that “obviousness requires a suggestion of all limitations in a claim.” *See In re Wada and Murphy*, Appeal 2007-3733, *citing CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Circ. 2003) (citing *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)). Applicants submit that none of the cited art teaches or suggests the use of the compounds in the present claims to treat primary open angle glaucoma. In particular, it is submitted that the teaching of Clark *et al.* fails to cure the conceded deficiency in Xiao, and that the asserted combination of Xiao and Clark *et al.* therefore fails to render the instant claims obvious.

The Action concedes that Xiao does not teach or suggest the use of histone deacetylase inhibitors for treating primary open angle glaucoma (see page 3 of the Office Action). Nevertheless, the Action rejects the instant claims, asserting that Clark *et al.* provides the necessary disclosure. In particular the Action states that Clark *et al.* teach that treatment of neovascular conditions of the eye includes chronic glaucoma (see page 3 of the Office Action). Thus, the Action contends that the teachings of Xiao and Clark *et al.* render the instant claims obvious. Applicant respectfully traverses this contention.

The rationale to support a conclusion that the claim would have been obvious is that “a person of ordinary skill in the art would have been motivated to combine the prior art to

achieve the claimed invention and that there would have been a reasonable expectation of success.” MPEP §2143 (G).

Xiao relates to certain histone deacetylase inhibitors; Clark *et al.* relates to substituted hydrindanes. These are completely different compounds. One of skill in the art would not necessarily have a reasonable expectation that a histone deacetylase inhibitor would be successful in treating diseases that are treated with a substituted hydrindane.

Furthermore, Xiao discloses methods for treating diabetic retinopathy and neovascular glaucoma; Clark *et al.* discloses methods for preventing or treating chronic glaucoma. These are different diseases. One of skill in the art would not necessarily have a reasonable expectation that compounds useful for treating diabetic retinopathy and neovascular glaucoma would successfully treat primary open angle glaucoma, based on the teachings of these two references.

Nevertheless, the Action appears to be stating that Clark *et al.* teach a general principle that a compound useful for treating neovascularization must also be useful for treating primary open angle glaucoma. On the contrary, Clark *et al.* specifically relates to methods for controlling neovascularization with substituted hydrindanes. Clark *et al.* disclose that the substituted hydrindanes are useful for preventing and treating ocular neovascularization, and lists chronic glaucoma as a particular disease that may be prevented or treated by such compounds. But the teachings of Clark *et al.* have nothing at all to do with histone deacetylase inhibitors, and do not teach or suggest that any compound that may be useful for treating neovascularization will necessarily be useful for treating primary open angle glaucoma. Thus, one of skill in the art at the time of filing would have viewed Clark *et al.* as teaching what is disclosed, that substituted hydrindanes are useful for controlling neovascularization.

In view of the foregoing discussion, Applicant submits that the combination of Xiao and Clark *et al.* do not render Claim 1 obvious. Consequently, Applicant respectfully requests that this ground of rejection be withdrawn.

CONCLUSION

This is submitted to be a complete response to the outstanding Action. Based on the foregoing arguments, the claims are believed to be in condition for allowance; a notice of allowability is therefore respectfully requested.

The Examiner is invited to contact the undersigned attorney at (817) 615-5330 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

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Date: July 22, 2009